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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/072,784	05/06/1998	BARIN GEOFFRY HASKELL		6905

7590 03/13/2003

Samuel H Dworetsky
AT&T Corp
P O Box 4110
Middletown, NJ 07748-4110

EXAMINER
CHEN, WENPENG

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/072,784	HASKELL ET AL.	
	Examiner	Art Unit	
	Wenpeng Chen	2624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See the attachment please*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *29,30,34,35 and 39-44*.

Claim(s) withdrawn from consideration: *1-28,31-33 and 36-38*.

8.☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Wenpeng Chen 3/12/03

Wenpeng Chen
Primary Examiner
Art Unit: 2624

Examiner's responses to Applicants' remark

Applicants' arguments filed on 2/24/2003 have been fully considered but they are not persuasive.

a. Applicants' argument -- The Applicants disagree for the reasons stated in prior correspondence.

Examiner's response -- Applicants should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicants merely made a statement. Applicants must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

b. Applicants' argument -- Based on the Applicants' declarations, Suzuki et al. (US patent 6,097,842) is disqualified as a 102(e) prior art, because the Applicants (inventors) developed the scalability syntax before the filing date of Suzuki's US patent.

Examiner's response -- The Examiner disagrees with this conclusion. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections in the prior actions:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The paragraphs of 35 U.S.C. 102 clearly indicates that one type of 102(e) reference is "an application for patent, published under section 122(b), *by another filed in the United States* ***before the invention*** *by the applicant for patent."* The phrase "before the invention" is the key for the Examiner's conclusion.

In the remark, the representative of the Applicants argued that the inventors' declarations prove that the Applicants developed the scalability syntax before the filing date of Suzuki's US patent. A feature, such as scalability syntax of a system or method, only is not an invention. As disclosed in the present specification, an "invention" comprises many features that have interrelationship. Development of scalability syntax of a system or method does not equal development of the system or method. The declarations do not state that the attached documents to the declarations disclosed the **whole** invention. In other words, the attached documents do not prove that the Applicants invented the invention not later than the publication dates of the documents.

Therefore, the argument with the declarations *does not establish that the invention was made before the filing date of Suzuki's US patent.* The Suzuki's US patent remains as a valid 102(e) reference.